

MARC HUSEMANN ET AL.
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Polk
Conley by thermal treatment of the now deprotected polyacrylates.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the following comments.

The Examiner rejected claims 1, 2, 11 and 12 under 35 U.S.C. 112, first paragraph, for lack of enablement. According to the Examiner, the specification does not reasonably provide enablement for polyacrylate copolymers containing hydroxyl groups and no tert-butoxycarbonyl groups and a photoinitiator. Additionally, the Examiner argues that no photoinitiator would be

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required if a polyacrylate containing only hydroxyl groups is employed. In response, Applicants remind the Examiner of the factors for determining enablement:

- A) The breadth of the claims;
- B) The nature of the invention;
- C) The state of the prior art;
- D) The level of one of ordinary skill;
- E) The level of predictability in the art;
- F) The amount of direction provided by the inventor;
- G) The existence of working examples; and
- H) The quantity of experimentation need to make or use the invention based on the content of the disclosure.

See In re Wands, 8 USPQ2d 1400 (Fed. Cir. 1988); *See also* MPEP §2164.01(a). Further, it is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors, and a conclusion of enablement must be made on the evidence as a whole. *See In re Wands*, 8 USPQ2d at 1404; *See also* MPEP §2164.01(a). In the above-referenced application, the Examiner appears to focus on only factor A) as to the breadth of the claims. However, Applicants point to the above factors F) and G) and submit that someone of ordinary skill in the art would understand the claims when read in light of the specification. Applicants point out that a photoinitiator is required whether the groups are protected or not, wherein the specification at page 6, lines 26-28 recites the following: "The protons required for crosslinking with the

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polyfunctional epoxides are present because of the acid generated by the photocationic initiator”.

Thus, Applicants point out that the photoinitiator aids in crosslinking, even in the absence of a deprotective function. In addition, there is considerable direction and guidance as to the photoinitiator wherein working examples are disclosed starting at page 9 of the specification.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Claims 1-8, 11 and 12 are rejected under 35 U.S.C. 112, second paragraph for being indefinite. The Examiner found the term “obtainable” indefinite. In response, Applicants submit that ‘obtainable’ is an art-recognized term, wherein a search of the USPTO website on December 5, 2002 revealed 3499 patents *having claims* which employed the term “obtainable”, wherein 781 of those patents also employed the term “polymer(s)” and, therefore, presumably are in the polymer art.

The Examiner also found the term “% by weight based on the polymer mixture of claim 1” as indefinite. In response, Applicants submit that the total weight is based on the polymer mixture which comprises components a), b) and c). Further, there is an antecedent basis for the polymer mixture in claim 1, wherein the applicable portion of claim 1 recites the following: “A

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polyacrylate obtainable by thermal crosslinking of a polymer mixture..."

The Examiner also rejected claims 3-6 for not setting forth the method for deprotecting the polymers. In response, Applicants submit the claims have now been amended to show the polymer to be deprotected with the polymerization regulating photoinitiator.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

The Examiner rejected claims 1, 2, 11 and 12 under 35 U.S.C. 103(a) as being obvious over Wesp (U.S. Patent No. 3,765,972). According to the Examiner, Wesp teaches adhesive compositions comprising a film-forming latex and a transient tackifier comprising an epoxy resin and a curing agent, such as an amine. The Examiner further found that Wesp does not mention a photoinitiator. The Examiner ultimately finds that it would have been obvious to obtain a polyacrylate by thermal crosslinking without the addition of a photoinitiator, because there are no protected hydroxyl groups to be deprotected. In response, Applicants submit that the Examiner has not made out a *prima facie* case for obviousness. As the proponent of this rejection, the burden was squarely on the Examiner to make out a *prima facie* case of obviousness; only when the Examiner's burden was carried forward did the burden then shift to Applicants to provide any

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proof of nonobviousness. *In re Piasecki et al.*, 223 USPQ 785, 788 (Fed. Cir. 1984). Applicants point out that there is no suggestion or motivation to modify the reference to obtain the present invention, wherein the required photoinitiator element is clearly not taught in the reference. Further, the Examiner is required to establish that all the claim limitations are taught or suggested in the prior art. *In re Royka*, 490 F.2d. 981, 180 USPQ 580 (CCPA 1974). The Examiner premised her argument on the finding that a polyacrylate is obtained *without* the addition of a photoinitiator in view of the Wesp reference. The claims, however, explicitly *require* a polymerization regulating photoinitiator in obtaining the polyacrylate. The Examiner fails to take into account the required photoinitiator element in the claim limitations and show where this feature of the present claims is taught or suggested by the prior art. In the absence of such showing, the Examiner has not made out a *prima facie* case of obviousness.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance.

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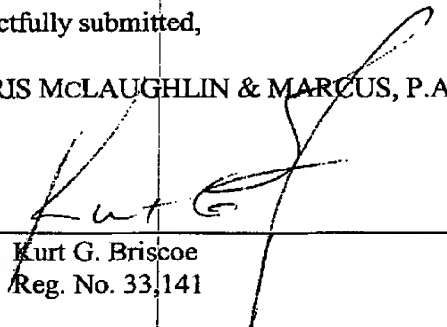
However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By


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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 and the attached Mark-Up Showing the Changes Made in the Previous Claim to Yield the Claim as Amended Above and the accompanying Petition for Extension of Time (12 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: December 4, 2002

By


Kurt G. Briscoe

MARK-UP SHOWING THE CHANGES MADE IN THE PREVIOUS CLAIM TO YIELD THE CLAIM AS AMENDED ABOVE

3. (Amended Twice) A process for preparing a crosslinked polyacrylate according to claim 1, wherein the polymers to be crosslinked are first protected by introduction of tert-butoxycarbonyl groups and the crosslinking takes place only after [the deprotection] deprotecting with a polymerization regulating photoinitiator, by thermal treatment of the now deprotected polyacrylates.

4. (Amended Twice) A process for preparing a crosslinked polyacrylate according to claim 1, wherein the polymers to be crosslinked are first protected by introduction of tert-butoxycarbonyl groups and the crosslinking takes place only after [the deprotection] deprotecting with a polymerization regulating photoinitiator, by adding crosslinker substances and by thermal treatment of the now deprotected polyacrylates.

5. (Amended Twice) A process for preparing a crosslinked polyacrylate according to claim 1, wherein the polymers to be crosslinked are first protected by introduction of tert-butoxycarbonyl groups and the crosslinking takes place only after [the deprotection] deprotecting with a polymerization regulating photoinitiator, by adding difunctional or polyfunctional isocyanates and by thermal treatment of the now deprotected polyacrylates.

6. (Amended Twice) A process for preparing a crosslinked polyacrylate

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according to claim 1, wherein the polymers to be crosslinked are first protected by introduction of tert-butoxycarbonyl groups and the crosslinking takes place only after [the deprotection] deprotecting with a polymerization regulating photoinitiator, by adding difunctional or polyfunctional epoxides and by thermal treatment of the now deprotected polyacrylates.